REMARKS

The Examiner is thanked for this Office Action, and especially for his helpful comments. Claims 1-28 are pending. Claims 1, 3, 5, 6, 8, 25 and 27 are amended, Claims 15-24 are canceled without prejudice to their reintroduction in a continuation application, and new Claims 29-46 are added. Reconsideration in view of the amendments and of the following remarks is respectfully requested.

Drawings

The objections to the drawings are noted. Formal drawings are enclosed to replace the drawings previously submitted..

35 U.S.C. § 101, Non-Statutory

The Office Action rejects Claim 22 as non-statutory, noting:

> "Claim 22 is rejected under 35 U.S.C. § 101 because it is directed to a non-statutory subject matter. This claim is essentially directed to a nonfunctional descriptive material (a computer program per se) on a computer storage medium (broadly claimed as an article of manufacture)"

This rejection is traversed. It is submitted that the article of manufacture claimed reads, for example, upon a safe card containing an electronic receipt. This application is directed to showing the functionality of such a receipt on such a card. However, to avoid further argument, this claim has now been canceled and this rejection is now believed to be moot.

35 U.S.C. § 112(1), Not Enabled

The Office Action rejects Claims 25-28 as not enabled by the specification. This rejection is traversed. The Examiner, in his rejection, has stated:

> "Claims **25-28** are rejected under 35 U.S.C 112, first paragraph, as based on a disclosure which is not enabling. The computer program which perform purchase transactions in claims 25-28 was not disclosed. Such computer program for generating, receiving, reading, validating and electronic receipt is critical/essential to the practice of the invention, but no disclose in the claims; therefore, is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976)."

It is respectfully submitted that support for a computer program that performs the disclosed actions is found in the instant application at page 28, line 24 through page 29, line 5, which states:

> "It is important to note that while the present invention has been described in the context of a fully functioning data processing system, those of ordinary skill in the art will appreciate that the processes of the present invention are capable of being distributed in the form of a computer readable medium of instructions and a variety of forms and that the present invention applies equally regardless of the particular type of signal bearing media actually used to carry out the distribution. Examples of computer readable media include recordable-type media such a floppy disc, a hard disk drive, a RAM, and CD-ROMs and transmission-type media such as digital and analog communications links."

Thus, this rejection is believed to be overcome.

II.   35 U.S.C. § 103, Obviousness

The Office Action rejects all claims under 35 U.S.C. § 103(a) as unpatentable over Tognazzini in view of the Official Notice. This rejection is respectfully traversed.

With regard to the rejection, the Office Action states:

> "All the claims are directed to the use of e-receipt for online transactions wherein all claims' limitations can be found in the US patents of Tognazzini (US Pat. 5,739,512), Vaghi (US Pat. 6,047,273), Beatson et al., (US Pat 5,892,824, and Muftic (US Pat. 5,850,442). In their disclosures, they utilized e-receipts and validating them for different purposes.
> The Official Notice is taken here that the following limitations are notorious well-known in the art (at least from cited references):
> - processing means for processing a transaction;
> - generating means for generating e-receipts for above transaction;
> - storing means for storing e-receipts;
> - reading means for reading e-receipts;
> - validating means for validating e-receipts;
> - indicating means for providing an indication to proceed with a delivery of related goods/services;
> - inspection means for inspecting a digital signature of e-receipts.
> The examiner submits that all claimed limitations are so obvious/notoriously well-known in a computer system, because these claimed limitations are very broad that they are easily recognized by artisan in the art to be ability/features/components of a computer system and said components would perform claimed tasks/steps; cited prior art's limitations are not necessary spelled-out exactly claimed languages, because cited prior art is also directed to a similar process/system for communicating between sellers and buyers through

e-receipts. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although cited disclosures have been described in connection with specific preferred embodiments, it would be understood that their subject matter should not be unduly limited to such specific embodiments."

It is submitted that the Examiner has presented an extremely broad, nonspecific rejection of the claims and has not met his burden for a prima facie case of obviousness.

A fundamental notion of patent law is the concept that invention lies in the new combination of old elements. A rule that every invention could be rejected as obvious by merely locating each element of the invention in the prior art and combining the references to formulate an obviousness rejection is inconsistent with the very nature of "invention." Consequently, a rule exists that a combination of references made to establish a *prima facie* case of obviousness must be supported by some teaching, suggestion, or incentive contained in the prior art which would have led one of ordinary skill in the art to make the claimed invention.

The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). It is submitted that the examiner has not pointed out where in the references he has found the limitations of the individual claims, nor where in the references he has found a motivation to modify or combine these limitations.

Of the references, Beatson et al. is directed to capturing and verifying a signature and saving a copy of the signature electronically, Vaghi is directed to remotely providing mailing/shipping services to customers, and Muftic is directed to providing electronic commerce over the Internet. Tognazzini appears to be the only one of the references that even mentions an electronic receipt stored on a smart card or safe card. In the midst of these numerous inventions, the Examiner has not pointed to specific limitations or specific motivations to combine these limitations.

If the examiner maintains his rejection, Applicants respectfully request, under 37 C.F.R. § 1.104(c), that the examiner point out the particular parts respectively of Tognazzini, Vaghi, Beatson and Muftic relied on, since these patents describe inventions

other than that claimed by the applicant.

To the extent that Applicant can understand the Examiner's very general rejections, the following arguments are submitted.

Tognazzini appears to disclose a digital receipt that is generated in response to a purchase. Tognazzini is mainly directed to providing this digital receipt to the consumer, and optionally to other interested parties, via e-mail, but he does mention the situation in which

> "A customer (e.g., traveler) gives the cashier a smart card (700) upon which a receipt is to be recorded. The cashier inserts the smart card into the card reader/writer (710) and when payment is made (720), the receipt is written into smart card memory (730)." - (column 6, lines 55-59)

Tognazzini, however, does not appear to contemplate using this stored information to accomplish any objectives other than providing the customer with a record for accounting purposes. The examiner has lumped together a number of additional references in his Official Notice to show that elements of the invention were known, but that is not the point. Rather, the disclosed arrangement of these elements has been disclosed as providing advantages which were not previously available. Therefore, it is respectfully submitted that at least the currently claimed inventions are patentably distinct from the art relied on.

The independent claims of the current application have been amended, or in some cases, they have been replaced by new claims, to more specifically point out the objectives which can be accomplished by use of the disclosed methods and apparatus.

With regard to amended Claim 1, this claim recites:

> "1.   A method for conducting a commercial transaction in a distributed data processing system, the method comprising the steps of:
>   recording an electronic receipt on a removable storage medium at a first data processing terminal, the electronic receipt comprising data concerning a commercial transaction;
>   receiving the removable storage medium at a second data processing terminal at a different time or location;
>   validating the electronic receipt stored on the removable storage medium at the second data processing system, and
>   in response to validating the electronic receipt, conducting a commercial transaction."

Support for the giving step is found in the application at page 21, lines 22-23. Neither Tognazzini nor the other mentioned references appears to disclose the use of a removable storage medium, such as a smart card or safe card, to provide authorization to deliver an item or service previously purchased.

With regard to amended Claim 3, this claim recites:

"3.   A method for processing an electronic receipt, the method comprising the computer-implemented steps of:
        processing a purchase transaction;
        generating an electronic receipt comprising data concerning the purchase transaction;
        storing the electronic receipt on a removable storage medium;
        reading the electronic receipt on the removable storage medium;
        validating the electronic receipt; and
        in response to validating the electronic receipt, providing an indication to proceed with a delivery of goods or services related to the purchase transaction and updating an inventory affected by said delivery of goods or services."

Support for updating an inventory can be found on page 23, lines 5-21 of the application. Neither Tognazinni nor the other mentioned references appear to disclose using the presentation of the removable storage medium containing the electronic receipt to trigger an update of the inventory affected.

With regard to amended Claim 5, this claim recites:

"5. (Amended) A method for processing an electronic receipt, the method comprising the steps of:
        receiving a removable storage medium;
        reading an electronic receipt from said removable storage medium;
        validating the electronic receipt; and
        in response to validating the electronic receipt, providing an indication to proceed with a delivery of goods or services related to a purchase transaction."

Support for the receiving step is found on page 21, lines 22-23 of the application. Neither Tognazinni nor the other mentioned references appear to disclose using the presentation of a removable storage medium as validating a right to receive goods or services.

With regard to amended Claim 25, this claim recites:

"25.   A computer program product in a computer-readable medium for conducting a commercial transaction, the computer program product comprising:

first instructions for recording an electronic receipt on a removable storage medium at a first data processing system, the electronic receipt comprising data concerning a commercial transaction;

second instructions for reading the removable storage medium after its receipt at a second data processing system;

third instructions for validating the electronic receipt stored on the removable storage medium at the second data processing system; and

fourth instructions for providing authorization for conducting a commercial transaction in response to validating the electronic receipt."

Support for the is found on page 22, lines 4-20 of the application. Neither Tognazinni nor the other mentioned references appear to disclose using the presentation of a removable storage medium containing an electronic receipt as validating a right to receive goods or services.

With regard to amended Claim 27, this claim recites:

"27.   A computer program product in a computer-readable medium for processing an electronic receipt, the computer program product comprising:

first instructions for processing a purchase transaction;

second instructions for generating an electronic receipt comprising data concerning the purchase transaction;

third instructions for storing the electronic receipt on a removable storage medium;

fourth instructions for reading the electronic receipt on the removable storage medium;

fifth instructions for validating the electronic receipt; and

sixth instructions for providing an indication to proceed with a delivery of goods or services related to the purchase transaction in response to validating the electronic receipt,

seventh instructions for updating an inventory in response to validating the electronic receipt."

Support for the updating step is found on page 22, lines 4-20 of the application. Neither Tognazinni nor the other mentioned references appear to disclose using an electronic receipt (rather than the initial transaction itself) to trigger an update to the inventory.

With regard to new Claim 34, this claim recites:

"34.   A method of processing a receipt, comprising the steps of:

receiving a removable storage media containing a first electronic receipt;

reading said first electronic receipt to validate a previous transaction;

conducting a new transaction which is affected by said previous transaction;

updating said first electronic receipt to reflect said new transaction."

Support for Claims 34 and 37 can be found on page 22 of the application, lines 4-20. Neither Tognazinni nor the other mentioned references appear to disclose updating an existing electronic receipt to reflect further action related to the receipt, such as the delivery of goods or the use of a rain check.

With regard to new Claim 37, this claim recites:

"37. A computer program product in a computer-readable medium for processing an electronic receipt, the computer program product comprising:

first instructions for processing a purchase transaction;

second instructions for generating a first electronic receipt comprising data concerning the purchase transaction;

third instructions for storing said first electronic receipt on a removable storage medium;

fourth instructions for reading said first electronic receipt from the removable storage medium;

fifth instructions for validating said first electronic receipt; and

sixth instructions for modifying said first electronic receipt."

Neither Tognazinni nor the other mentioned references appear to disclose computer program which not only reads and writes an electronic receipt, but which can update the receipt to reflect further actions.

With regard to new Claim 40, this claim recites:

"40. A method of processing a receipt, comprising the steps of:

conducting a commercial transaction between a consumer and a provider;

storing an electronic receipt for said commercial transaction on a computer readable media, wherein said electronic receipt contains additional information wherein said electronic receipt contains additional information beyond that given to document the transaction;

giving said computer readable media to a customer."

Support for Claims 40 and 42 can be found at page 12, lines 12-29 of the application. Neither Tognazinni nor the other mentioned references appear to disclose storing information on the electronic receipt which may not be necessary to document the transaction itself, but which will be useful to the consumer, such as a credit card number where a credit card company offers an extended warranty on items charged on their card.

With regard to new Claim 42, this claim recites:

"42. A computer program product in a computer-readable medium for processing an electronic receipt, the computer program product comprising:
first instructions for processing a purchase transaction;
    second instructions for generating an electronic receipt comprising data concerning the purchase transaction; and
    third instructions for storing said electronic receipt on a removable storage medium, along with additional information beyond that given to document the transaction."

Neither Tognazinni nor the other mentioned references appear to disclose a computer program which stores information on the electronic receipt which may not be necessary to document the transaction itself, but which will be useful to the consumer, such as installation guidelines.

With regard to new Claim 44, this claim recites:

"44. A method of processing a receipt, comprising the steps of:
    conducting a commercial transaction between a consumer and a provider;
    storing an encrypted electronic receipt for said commercial transaction on a computer readable media using an encryption method known only by the provider;
    giving said computer readable media to a customer;
    whereby consumer tampering with said receipt is prevented."

Support for Claims 44 and 45 can be found on page 20, line 18 through page 21, line 2 of the application. Neither Tognazinni nor the other mentioned references appear to disclose writing the electronic receipt in an encrypted form to prevent tampering.

With regard to new Claim 45, this claim recites:

"45. A computer program product in a computer-readable medium for processing an electronic receipt, the computer program product comprising:
    first instructions for processing a purchase transaction;
    second instructions for generating a first electronic receipt comprising data concerning the purchase transaction;
    third instructions for storing said first electronic receipt on a removable storage medium in an encrypted form;
    fourth instructions for reading said encrypted form of said first electronic receipt from the removable storage medium; and
    fifth instructions for validating said first electronic receipt."

Neither Tognazinni nor the other mentioned references appear to disclose a computer

program which will write the electronic receipt in an encrypted form to make tampering more difficult.

Reasons for Amendments

It is noted that the claim amendments accompanying this paper are made in order to more fully clarify the invention as disclosed.
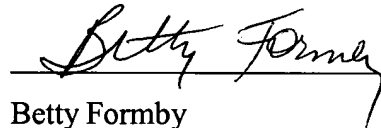
Conclusion

It is respectfully urged that the rejections have been overcome and that the claimed subject matter is patentable over Tognazinni and the Official Notice and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: _September 14, 2001_

Respectfully submitted,

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APPENDIX: REDACTED CLAIMS:

1. (AMENDED) A method for conducting a commercial transaction in a distributed data processing system, the method comprising the [computer-implemented] steps of:

recording an electronic receipt on a removable storage medium at a first data processing [system] terminal, the electronic receipt comprising data concerning a commercial transaction;

[reading] receiving the removable storage medium at a second data processing [system] terminal at a different time or location;

validating the electronic receipt stored on the removable storage medium at the second data processing system, and

in response to validating the electronic receipt, conducting a commercial transaction.

3. (AMENDED) A method for processing an electronic receipt, the method comprising the computer-implemented steps of:

processing a purchase transaction;

generating an electronic receipt comprising data concerning the purchase transaction;

storing the electronic receipt on a removable storage medium;

reading the electronic receipt on the removable storage medium;

validating the electronic receipt; and

in response to validating the electronic receipt,

providing an indication to proceed with a delivery of goods or services related to the purchase transaction and

updating an inventory affected by said delivery of goods or services.

5.   (AMENDED) A method for processing an electronic receipt, the method comprising the [computer-implemented] steps of:

receiving a removable storage medium;

reading an electronic receipt from [a] said removable storage medium;

validating the electronic receipt; and

in response to validating the electronic receipt, providing an indication to proceed with a delivery of goods or services related to a purchase transaction.

6.   (AMENDED) The method of claim 5 further comprising:

processing a purchase transaction;

generating an electronic receipt comprising data concerning the purchase transaction; and

storing the electronic receipt on [a] said removable storage medium;

wherein said removable storage medium remains with a consumer.

8.   (AMENDED) The method of claim 5 further comprising:

prior to validating the electronic receipt, selecting one of a plurality of electronic receipts in accordance with [user] input from a consumer.

25.   (AMENDED) A computer program product in a computer-readable medium for conducting a commercial transaction, the computer program product comprising:

first instructions for recording an electronic receipt on a removable storage medium at a first data processing system, the electronic receipt comprising data concerning a commercial transaction;

second instructions for reading the removable storage medium after its receipt at a second data processing system;

third instructions for validating the electronic receipt stored on the removable storage medium at the second data processing system; and

fourth instructions for providing authorization for conducting a commercial transaction in response to validating the electronic receipt.

27.   (AMENDED) A computer program product in a computer-readable medium for processing an electronic receipt, the computer program product comprising:

first instructions for processing a purchase transaction;

second instructions for generating an electronic receipt comprising data concerning the purchase transaction;

third instructions for storing the electronic receipt on a removable storage medium;

fourth instructions for reading the electronic receipt on the removable storage medium;

fifth instructions for validating the electronic receipt; and

sixth instructions for providing an indication to proceed with a delivery of goods or services related to the purchase transaction in response to validating the electronic receipt,

seventh instructions for updating an inventory in response to validating the electronic receipt..

Changes to the specification:

At Page 24, paragraph of Lines 15-31:

--   Although it is assumed that both the merchant and the consumer act honorably and reasonably during the history of any and all purchase transactions, situations may arise in which a safe card does not properly reflect what is stored in the merchant server or what is remembered by either the merchant or the consumer. To prevent these circumstances, an audit trail or transaction log may be stored simultaneously on the merchant server and on the safe card. When the transaction logs fail to match, the burden of correcting any discrepancies may be placed on the merchant because the merchant has the opportunity to encrypt the information on the safe card to prevent tampering with the information on the safe card. The storage of information on the safe card and on the merchant server is also under the control of the merchant, making it rather difficult for the consumer to create false records.--